



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.

FILING DATE

FIRST NAMED INVENTOR

ATTORNEY DOCKET NO.

09/483,537

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WILSON

R

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EXAMINER

BERGIN, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

09/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/483,537

Applicant(s)

WILSON, ROBERT D.

Examiner

James S. Bergin

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-4, 6-10 and 12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of species A (figure 2) and D (figure 5) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that species A and D are embodiments of a distinct invention represented by the group of claims 1-12. This is not found persuasive and the examiner maintains the position that species A (figure 2) and D (figure 5) are patentably distinct species of the same invention represented by the group of claims 1-12 and as such, maintains the requirement that the applicant further elect between the embodiment of species A (figure 2) and D (figure 5). On page 4 of the specification of this application, figure 2 is described as: "*Fig. 2 is a schematic diagram of a first preferred embodiment of the present invention*", and on page 6, of the specification, figure 2 is further described as: "*Referring to Fig. 2, an embodiment of the present invention in which an individual 30 obtains a spending vehicle 34 directly from a spending vehicle provider such as a sponsor 36 is shown*". However, figure 5 has been described on page 4 as: "a schematic diagram of a fourth preferred embodiment of the present invention", and again on page 10: "*Fig. 5, shows another embodiment of the present invention in which a particular third party spending vehicle provider is not necessary. Instead, a financial institution 116 (perhaps the bank where the individual banks), for example, issues a spending vehicle 114 directly to the individual 110 that may be used at different outlets for the purchase of goods or services*". Species A (figure 2) and D (figure 5) are clearly patentably distinct species which would each involve a radically divergent search, thus placing an undue burden on the examiner.

Art Unit: 2164

The election of species requirement is still deemed proper and is therefore made FINAL.

2. In the amendment filed 7/5/2001 the applicant states that: *"The applicant cancels claims 13-20 without prejudice"*. However, the examiner notes that claims 13-20 have not actually been formally canceled by this amendment. Claims 13-20 have been withdrawn from examination at this time for being drawn to a non-elected species of the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 7-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kemp, "Discover Debuts Its First Platinum Card", DM News.

Kemp discloses a system and method for distributing payment vehicles comprising: payment rights such as a rebate for an owner of a Discover card entitled to receive a refund from the Discover card company; a sponsor of spending vehicles, such as gift certificates, being the Discover card company, said gift certificates redeemable at one of Discover's Platinum Partners; an assignment of payment rights, such as the rebate entitlement, by the owner of the credit card back to the Discover card company in return for which the Discover card company issues spending vehicles back to the card owner in an amount related to the assigned payment rights.

Art Unit: 2164

Discover card company acts as a payor in that it transfers a payment to the relevant one of the Discover Platinum Partners in accordance with the assignment of the rebate entitlement.

Regarding claims 3 and 4, Discover Card Company, the sponsor of the spending vehicles is a financial institution.

Regarding claim 6, Kemp discloses that the value of the gift certificates issued by Discover card exceeds the value of the assignment of the rebate entitlement.

Response to Arguments

5. Applicant's arguments filed 7/5/2001 have been fully considered but they are not persuasive. As currently claimed, the applicant's claims do not distinguish over the applied reference; Kemp, "Discover Debuts Its First Platinum Card", DM News.

6. Discover Card Company acts as a payor in that it transfers a payment to the relevant one of the Discover Platinum Partners in accordance with the assignment of the rebate entitlement. The applicant argues that: "*independent claim 1 is distinguished by a payment right arising from a payment coming from a payor. The assignment directs payment from the payor to a sponsor or financial institution*". As currently claimed in independent claims 1 and 7, the "*sponsor of spending vehicles*" and the "*payor for transferring a payment*" have not been claimed or defined as separate entities. This the Kemp rejection is still proper and has now been made final.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.

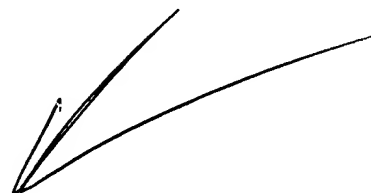
Art Unit: 2164

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

A handwritten signature in black ink, appearing to read "James S. Bergin", followed by a horizontal line.

James S. Bergin

Examiner
September 10, 2001

A stylized handwritten signature in black ink, consisting of a few sweeping lines.

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100